

AMENDMENTS TO THE DRAWINGS:

In the Office Action at item 1, the drawings are objected to under 37 C.F.R. § 1.83(a). Applicant cancels claim 7 without prejudice or disclaimer to obviate this objection.

In the Office Action at item 2, the Examiner objected to Figure 4. In order to overcome the objection, a replacement sheet containing Figure 4 to replace the original sheet containing Figure 4 is submitted herewith. In Figure 4, the legend --PRIOR ART-- is added.

For the convenience of the Examiner, an annotated sheet showing the changes made is attached. Approval of these changes to the drawings is respectfully requested.

REMARKS

The Office Action rejected claims 1-14, and the Office Action objected to the drawings. The rejections and objections are obviated below, and reconsideration of all claims is respectfully requested.

Applicant amends Figure 4, cancels claims 7 and 14 without prejudice or disclaimer, and amends claims 2 and 9. Accordingly, claims 1-6 and 8-13 are pending.

Objections to the Drawings

In point 1 on page 2 of the Office Action, the Office Action objects to the drawings under 37 C.F.R. § 1.83(a) because the drawings do not show “the non-tubular shaped jacks as required by claim 7.” Applicant cancels claims 7 and 14, which refer to “the grounding jack and the power supplying jack are non-tubular shaped” to obviate the objection. However, cancellation of dependent claims 7 and 14 do not impact the scope of the independent claims 3 and 9 from which claims 7 and 14 depend, respectively.

For example, the doctrine of claim differentiation reflects the presumption that separate claims are of different scope. See, Irving Kayton, 1 *Patent Practice* (6th ed.) 3.1, 3.3 (1995):

[P]atent practitioners typically draft a series of claims approximating a spectrum of patent protection The first way in which a claim may be made narrower is by adding a limitation to it in the form of an additional element.

Smith and Nephew, Inc. v. Ethicon Inc., 276 F.3d 1304, 61 U.S.P.Q.2d 1065, 1069 (Fed. Cir. 2001).

Accordingly, claim 3 recites a “power supplying jack” and a “grounding jack.” Claim 4 recites, “the power supplying jack includes . . . a tubular grounding conductor coaxial with the terminal,” and claim 5 recites, “the grounding jack includes a tubular grounding conductor.”

The specification supports this claim language. For example, page 6, paragraph [0022] of the specification recites:

“The second grounding terminal 57 has the same cross-section and is the same size as the tubular first grounding terminal 47 of the power supplying jack 41. . . . However, it is understood that the cross-sections do not need to be the same in all aspects of the present invention and that other types of grounding jacks could be used.”

Accordingly, based on the doctrine of claim differentiation, the power supplying jack and the grounding jack are not limited to a tubular grounding conductor. This is fully supported by the specification, drawings and claims 3-5. In addition, by canceling claims 7 and 14 applicants are not relinquishing any subject matter, as the same is still maintained by at least the independent claims.

For similar reasons, the scope of claim 9 is not impacted by the cancellation of claim 14.

Rejection of Claim 2 Under 35 U.S.C. § 112(2)

Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 2 is amended to correct a typographical error by replacing “jack” with “terminal--.” Because Applicant is amending claim 2 to correct a typographical error, it is respectfully submitted that this change does not impact the scope of claim 2.

Rejection of Claims Under 35 U.S.C. § 103(a)

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2004/0018774 to Long et al. (hereinafter referred to as “Long”) in view of U.S. Patent 4,025,139 to Martucci. This rejection is respectfully traversed.

Long and Martucci taken alone or in combination do not disclose, teach or suggest at least,

“a power supplying jack provided at an end of the DC power cable and connected to one of the first connection port of the computer main body and the second connection port of the docking station to supply DC power therethrough;

a grounding jack provided at an end of the grounding cable and connected to the other one of the first connection port of the computer main body and the second connection port of the docking station to connect the grounding cable and one of the grounding areas of the computer main body and the docking station to each other,”

as recited in claim 1.

Instead, Long discloses an AC/DC adapter for notebook computers, which is directed toward ensuring that the notebook computer does not attempt to draw more power than the rated level power, which can be provided by the adapter (paragraph 32 on page 2 of Long).

In addition, as conceded in the Office Action, “Long does not disclose a second cable branched off from the power supply cable with a jack at one end” (page 4, point 5, lines 7-8 of

the Office Action).

To overcome this deficiency, the Office Action asserts, "It would have been obvious to one skilled in the art at the time of the invention to combine the AC/DC adapter and connection jacks of Long with the auxiliary grounding wire of Martucci to obtain an AC/DC adapter capable of electrically connecting to both the computer and the docking station where one device would receive electrical power and both would be directly connected to the ground plane of the AC/DC adapter" (page 4, point 5, lines 10-15 of the Office Action). Applicants respectfully disagree.

Martucci discloses a redundant electrical grounding system for a hospital bed. As shown in Figure 1 of Martucci, both ground conductors 4 and 5 are connected to one device, which is a hospital bed.

Accordingly, it is respectfully submitted that Long and Martucci, alone or in combination, do not disclose, teach or suggest at least "a power supplying jack . . . connected to one of . . . the computer main body and . . . the docking

station . . ." and "a grounding jack . . . connected to the other one of . . . the computer main body and . . . the docking station," because Long does not disclose a second cable, and Martucci's ground conductors 4 and 5 are connected to the same hospital bed.

Moreover, to set forth a *prima facie* §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence outside the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference, i.e., evidenced motivation is required; conclusions without evidence are insufficient. Similarly, an "obvious to try" rationale for combining two references is not valid motivation under 35 U.S.C. § 103. In re Goodwin, 576 F.2d 375, 377, 198 U.S.P.Q. 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 U.S.P.Q. 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 U.S.P.Q. 623 (CCPA 1966).

Conversely, the Office Action appears to have only set forth a conclusion, without indicating where (or how) the cited motivation is derived. It would appear that the cited motivation is only a conclusion of the Examiner without evidence.

Thus, it is respectfully submitted that there would not have been motivation to combine Long's power adapter for a notebook computer with Martucci's hospital bed. Therefore, for at least these reasons, it is respectfully submitted that claim 1 patentably distinguishes over the cited references.

Claim 2 depends directly from claim 1 and includes all of the features of that claim plus additional features which are not taught or suggested by the reference. Therefore, it is respectfully submitted that claim 2 also patentably distinguishes over the cited reference.

Similarly, Long and Martucci taken alone or in combination do not disclose, teach or suggest at least, "wherein the power supplying jack is connectable to one of the portable device and the docking station, and the grounding jack is connectable to the other one of the portable device and docking station to supply a ground path other than through the power supplying jack," as recited in independent claim 3. Therefore, for at least these reasons, it is respectfully submitted that claim 3 also patentably distinguishes over the cited references.

Claims 4-6 and 8 depend directly or indirectly from claim 3 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, for at least these reasons, it is respectfully submitted that claims 4-6 and 8 also patentably distinguish over the cited references.

Similarly, Long and Martucci taken alone or in combination do not disclose, teach or suggest at least, "wherein the power supplying jack is for connecting to the first electrical device and the grounding jack is for connecting to the second electrical device," as recited in claim 9. Therefore, for at least these reasons, it is respectfully submitted that claim 9 also patentably distinguishes over the cited references.

Claims 10-13 depend directly or indirectly from claim 9 and include all the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, for at least these reasons, it is respectfully submitted that claims 10-13 also patentably distinguish over the cited references.

Summary

Claims 1-6 and 8-13 are pending and under consideration. It is respectfully submitted that none of the references taken alone or in combination disclose the present claimed invention.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

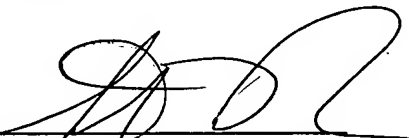
Respectfully submitted,

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1/13/05

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Serial No. 10/730,090
Group Art Unit: 2835
Inventor: Jea-woo PARK
Title: AC/DC Adapter and Notebook Computer Using the Same
REPLACEMENT SHEET

FIG. 4
PRIOR ART

